

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 620-128

KOUZARIDES

C# M#

Serial No. 09/744,469

Group Art Unit: 1658

Filed: January 25, 2001

Examiner: Kam, C.

Date: August 23, 2002

Title: ASSAYS, METHODS AND MEANS FOR MODULATING NUCLEAR
LOCALIZATIONAssistant Commissioner for Patents
Washington, DC 20231

TECH CENTER 1600/2900

AUG 26 2002

RECEIVED

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Fees are attached as calculated below:

Total effective claims after amendment 0 minus highest number
previously paid for 20 (at least 20) = 0 x \$ 18.00 \$ 0.00

Independent claims after amendment 0 minus highest number
previously paid for 3 (at least 3) = 0 x \$ 84.00 \$ 0.00

If proper multiple dependent claims now added for first time, add \$280.00 (ignore improper) \$ 0.00

Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s) (\$110.00/1 month; \$400.00/2 months; \$920.00/3 months) \$ 0.00

Terminal disclaimer enclosed, add \$ 110.00 \$ 0.00

☐ First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$740.00) \$ 0.00

☐ Please enter the previously unentered, filed

☐ Submission attached

Subtotal \$ 0.00

If "small entity," then enter half (1/2) of subtotal and subtract -\$ 0.00

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00) \$ 0.00

Assignment Recording Fee (\$40.00) \$ 0.00

Other: 0.00

TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.
By Atty: Mary J. Wilson, Reg. No. 32,955

Signature: Mary J. Wilson



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF

KOUZARIDES

Atty. Ref.: 620-128

Serial No.: 09/744,469

Group Art Unit: 1653

Filed: January 25, 2001

Examiner: Kam, C.

For: ASSAYS, METHODS AND MEANS FOR MODULATING NUCLEAR
LOCALIZATION

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AUG 26 2002
TECH CENTER 1600/2900

* * * * *

August 23, 2002

RESPONSE

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

Sir:

This is in response to the Examiner's requirement for restriction, set forth in the Office Action dated July 23, 2002, in the above. Applicants elect the subject matter of Group II (claims 2, 3, 10 and 11) for prosecution in this application. That election is made with traverse.

As the Examiner is aware, the present application represents the national phase of a PCT application. During the international phase, no lack of unity was found.

MPEP 1893.03(d) requires that an examiner, making a lack of unity of invention requirement, (1) list the groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general

inventive concept) specifically describing the unique
special technical feature in each group. Respectfully, no such specific explanation is provided by the Examiner here. The only justification offered by the Examiner is the general remark that "each group is directed to distinct chemical entities and/or methods which use different materials to produce different effects".

In requiring restriction, the Examiner makes reference to the PCT Rules and "special technical feature". However, the Examiner has not, in fact, applied the PCT rules.

In order that it will be clear as to what is meant by a "special technical feature", as defined in the PCT, attention is directed to 37 CFR 1.475(a) (the operative provision) which states:

An international application before the International Searching Authority will be considered to have unity of invention if the claims are in accordance with PCT Rule 13.

PCT Rule 13 states:

13.1 Requirement

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

13.2 Circumstances in Which the Requirement of Unity of Invention Is to

Be Considered Fulfilled (underlining added)

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(underlining added)

Thus, there is one and only one meaning for "special technical features". "Distinct" utilities or possible other uses, other chemical properties, physical structure are irrelevant and the PCT does not permit them to be taken into account. The sole test for unity is whether there is "one or more of the same or corresponding special technical features" as defined by the PCT, which is binding on this national phase application.

The Examiner's attention is directed to the fact that one contribution made by the present invention is the identification that CBP and Importin α interact. The interaction between the two proteins provides one contribution to the art that is reflected in all the claims as a special technical feature. The showing that one

acetylates the other and thus has a biological relevance represents yet another novel and unobvious contribution to the art providing a further unifying special technical feature.

In view of the foregoing, the Examiner is requested to reconsider the requirement for restriction and rejoin all the claims. Should the Examiner be inclined to maintain the requirement, however, her/his attention is directed to the fact that claim 5, presently grouped in Group III, is drawn to an assay method for an agent that affects the ability of Importin α to (i) bind Importin β , (ii) translocate into the nucleus, +/or (iii) import a cargo protein - the Examiner is urged to compare this language to that of claim 3, which is included in Group II. It is believed that having made that comparison, the Examiner will find it appropriate to rejoin claim 5 (and claims which depend therefrom) with Group II.

Again, the Examiner is reminded that all of the claims contain the same contribution to the art. That is, there of a single inventive concept under PCT and the requirement for restriction should therefore be withdrawn.

A response to the foregoing request for reconsideration is awaited.

Respectfully submitted,

NIXON & VANDERHYE, P.C.

By Mary J. Wilson

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